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REMARKS / ARGUMENTS

Applicant thanks the Examiner for reconsidering the restriction requirement and for examining the embodiments of both Species I and II (Figures 1-12).

Status of Claims

Claims 1-22 are pending in the application. Claims 5, 6 and 13-22 have been withdrawn from consideration as being drawn to a nonelected embodiment. Claims 1-4 and 7-12 stand rejected. Applicant has canceled Claims 5, 6 and 13-22 without prejudice, amended Claims 1, 3 and 4, and added new Claims 23-25, leaving Claims 1-4, 7-12 and 23-25 for consideration upon entry of the present Amendment. Applicant reserves the right to reinstate Claims 5, 6 and 13-22 at a later date, or to file a divisional application on such claims, as permissible under 35 U.S.C.

Applicant respectfully submits that the rejections under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §102(b), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Objections to the Specification

The Examiner objected to the Abstract of the disclosure because of informalities, including a word count in excess of 150 words.

Applicant has amended the abstract as suggested by the Examiner to correct for the informalities

Accordingly, Applicant respectfully requests reconsideration and withdrawal of this objection.

Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1-4 and 7-12 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

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The Examiner remarks that it is not clear from the disclosure how the load initiating element of the elected embodiments can be slideable within the housing and still function to lock the spring against the housing. Paper 03162005, page 4.

The Examiner further remarks that it is not clear from the disclosure how the piston 50 is capable of positioning the load initiating element, spring and inner tube without loading the spring into a self locking mode as required by Claim 4, and that the piston 50 does not appear capable of contacting the load initiating element. Paper 03162005, page 4.

Applicant traverses these rejections for the following reasons.

With regard to enablement, the law does not require a specification to be a blueprint in order to satisfy the requirement for enablement under 35 U.S.C. §112, first paragraph. *Staehelin v. Secher*, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992) (citing *In re Gay*, 309 F.2d 769, 135 USPQ 311 (C.C.P.A. 1962)). It has been consistently held that the first paragraph of 35 USC 112 required nothing more than objective enablement... How such a teaching is set forth, whether by the use of illustrative examples or by broad descriptive terminology, is of no importance since a specification which teaches how to make and use the invention in terms which correspond in scope to the claim *must* be taken as complying with the first paragraph of 35 UC 112 *unless* there is reason to doubt the objective truth of the statements relied upon therein for enabling support. *Staehelin v. Secher*, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992) (citing *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (C.C.P.A. 1971)) (emphasis in original).

Applicant has amended independent Claim 1 to now recite, inter alia,

"...wherein the load initiating element, spring, and compression member are slideable within the housing *in a first axial direction and in a second opposite axial direction in response to an axial load on the load initiating element, and lockable within the housing in the second axial direction in response to an axial load on the compression member in the second axial direction.*"

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No new matter has been added as antecedent support may be found in the specification as originally filed, such as at Paragraphs [0027-0030] and the various figures, for example.

In the embodiments disclosed and discussed in the specification as originally filed, and with reference to the several figures, the first and second axial directions of amended Claim 1 relate to movement to the right and to the left, respectively. No new matter has been added as one skilled in the art would recognize and appreciate this relationship from a reading of the application as originally filed.

For example, and with reference to Paragraph [0030] and Figures 9-10, Applicant discloses and teaches that movement of the piston 50 to the right (first direction) or the left (second direction) enables movement of the load initiating element 14, spring 22 and tube 18. By axially loading the piston 50 and absent an axial load on the tube 18, spring 22 is not compressed, thereby avoiding any locking action between spring 22 and housing 10, and providing for a sliding action of load initiating element 14, spring 22 and tube 18 within housing 10.

Additionally, and with reference to Paragraph [0027] and Figures 1-2, Applicant discloses and teaches that movement of tube 18 to the left (second direction) results in a locking arrangement due to the compression of spring 22 against housing 10 prior to the axial load overcoming the friction between the load initiating element 14 and the housing 10.

By the foregoing amendment and remarks, Applicant submits that the scope of Claim 1 is now commensurate with the exemplary embodiments disclosed in the specification, and as such, complies with the enablement requirement. More specifically, Applicant submits that one skilled in the art, after reading the specification and amended claims, would have a clear understanding of how the load initiating element of the elected embodiments can be slideable within the housing (in a first direction and a second direction in response to a load on the load initiating element, which produces in no appreciable compression of the spring) and still function to lock the spring against the

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housing (in the second direction in response to a load on the compression member, which produces appreciable compression of the spring).

Applicant has also amended Claim 4 to now recite, inter alia,

"...a piston slideably attached to the pin *via the load initiating element*;
wherein the load initiating element is resistive to movement relative to a longitudinal axis of the housing; and

wherein the piston, load initiating element, and pin are configured to slide the load initiating element, spring and inner tube within the outer tube *in the first and second axial directions in response to an axial load on the piston sufficient to overcome the resistance to movement without loading the spring into a self locking mode.*"

Here also, Applicant submits that no new matter has been added as antecedent support may be found in the specification as originally filed, as set forth above.

By the foregoing amendment and remarks, Applicant submits that the scope of Claim 4 is now commensurate with the exemplary embodiments disclosed in the specification, and as such, complies with the enablement requirement. More specifically, Applicant submits that one skilled in the art, after reading the specification and amended claims, would have a clear understanding of how the piston 50 is capable of positioning the load initiating element, spring and inner tube (in a first and second direction in response to an axial load on the piston) without loading the spring into a self locking mode (the locking mode being responsive to movement in the second direction in response to an axial load on the inner tube) as required by Claim 4.

Additionally, Applicant also submits that one skilled in the art, after reading the specification and amended claims, would have a clear understanding of how the piston 50 is capable of contacting the load initiating element 14. For example, at Paragraph [0030] Applicant discloses and teaches that pin 46 and piston 50 are added to the load initiating element 14, and that the arrangement moves in concert, and Figure 9 shows the piston 50 connected to the load initiating element 14 thereby enabling movement in concert.

Dependent claims inherit all of the limitations of the parent claim and any intervening claim.

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The Examiner has not brought into question the objective truth of the statements relied upon in the specification for enabling support of the claims, and the Applicant has provided clarifying remarks herein regarding where in the specification broad descriptive terminology is presented for enabling support of the amended claims.

Accordingly, and in view of the foregoing, Applicant respectfully submits that the specification provides general guidelines as to the scope of the invention such that one of ordinary skill in the art would know what was meant, and that the subject matter of the invention has been described and is supported in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention and provided an enabling disclosure thereof, and therefore respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §112, first paragraph, which Applicant considers to be traversed.

Rejections Under 35 U.S.C. §102(b)

Claims 1-4 and 7-11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Richards (U.S. Patent No. 4,691,889, hereinafter Richards).

Claims 1-4, 8-9 and 12 stand rejected under 35 U.S.C. §102(b) as being anticipated by Isaacson (U.S. Patent No. 3,788,626, hereinafter Isaacson).

Applicant traverses this comment for the following reasons.

Applicant respectfully submits that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, *in a single prior art reference.*" *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the *** claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Furthermore, the single source must disclose all of the claimed elements "arranged as in the claim." *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.

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Titanium Metals Corp. v. Banner, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

Applicant has amended Claims 1 and 4 as set forth and discussed above.

In comparing Richards and Isaacson with the claimed invention, Applicant submits that each of Richards and Isaacson separately fail to disclose:

"...wherein the load initiating element, spring, and compression member are slideable within the housing *in a first axial direction and in a second opposite axial direction in response to an axial load on the load initiating element, and lockable within the housing in the second axial direction in response to an axial load on the compression member in the second axial direction*", as set forth in Claim 1,

and fail to disclose:

"...a piston slideably attached to the pin *via the load initiating element*;

...wherein the piston, load initiating element, and pin are configured to slide the load initiating element, spring and inner tube within the outer tube *in the first and second axial directions in response to an axial load on the piston sufficient to overcome the resistance to movement without loading the spring into a self locking mode*," as set forth in Claim 4.

Dependent claims inherit all of the limitations of the parent claim and any intervening claim.

Accordingly, Applicant submits that Richards and Isaacson do not separately disclose all of the claimed elements, including their claimed attributes, arranged as in the claim, and respectfully submits that absent anticipatory disclosure in either Richards or Isaacson of each and every element of the claimed invention arranged as in the claim, both Richards and Isaacson cannot separately be anticipatory.

Furthermore, the Examiner alleges that Isaacson discloses each and every element of the originally claimed invention including a *spring (Isaacson reference numeral 37) slideable within the housing 10, 36*. Paper 03162005, page 5. Emphasis added.

Applicant respectfully disagrees that Isaacson discloses spring 37 *slideable* within the housing 10, 36.

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Contrary to the Examiner's allegation, Applicant finds Isaacson to disclose elastomeric member 37 to be *axially confined* at its leftward end... and at its rightward end. Column 3, lines 8-10 (emphasis added).

Since elastomeric member 37 is disclosed to be *confined at both ends*, it necessarily follows that elastomeric member 37 *cannot also be slideable* within the housing 10, 36.

Accordingly, Applicant respectfully submits that Isaacson does not disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory.

In view of the amendment and foregoing remarks, Applicant submits that the References do not separately disclose each and every element of the claimed invention arranged as claimed and therefore cannot be anticipatory. Accordingly, Applicant respectfully submits that the Examiner's rejection under 35 U.S.C. §102(b) has been traversed, and requests that the Examiner reconsider and withdraw of this rejection.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §112, first paragraph, and 35 U.S.C. §102(b), have been traversed, and respectfully request that the Examiner reconsider and withdraw these rejections.

Regarding New Claims 23-25

Applicant has added new Claim 23, which is dependent on Claim 1, and which includes additional limitations that even more specifically describe the subject matter regarded as the invention.

Applicant has also added new Claims 24-25, which are drawn to an invention similar to that of Claim 1, but in alternative language.

In view of the previous discussion relating to Claim 1, Applicant submits that the References do not disclose, teach or suggest the claimed inventions of new Claims 23-25, and do not motivate one to arrive at the claimed inventions.

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Accordingly, Applicant submits that new Claims 23-25 are directed to allowable subject matter and respectfully requests entry and notice of allowance thereof.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above identified Deposit Account.

Respectfully submitted,
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